



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,748	09/28/2001	Shinichi Kawai	P20873	2169

7055 7590 10/12/2005

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

MENBERU, BENIYAM

ART UNIT PAPER NUMBER

2626

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,748

Applicant(s)

KAWAI, SHINICHI

Examiner

Beniyam Menberu

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-18 is/are allowed.
- 6) ☒ Claim(s) 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Arguments

1. Applicant's arguments, see pages 9-21, filed June 13, 2005, with respect to the rejection(s) of claim(s) 1 under U.S. Patent No. 6167469 to SAFAI et al in view of U.S. Patent No. 6813036 to Matsushita, claim 2 under U.S. Patent No. 6813036 to Matsushita in view of U.S. Patent No. 6829607 to Tafoya et al, claim 8 under U.S. Patent No. 6167469 to Safai et al in view of U.S. Patent No. 6813036 to Matsushita, and claim 9 under U.S. Patent No. 6167469 to Safai et al in view of U.S. Patent No. 6813036 to Matsushita further in view of U.S. Patent NO.6829607 to Tafoya et al have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of JP2001-051922 to Naka.

Claim Objections

2. Claim 11 is objected to because of the following informalities:

On claim 11, line 2, "comprises a up key" should read "comprises an up key".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2626

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claim 10 and 11 are rejected under 35 U.S.C. 102(a) as being anticipated by JP2001-051922 to Naka.

Naka discloses a data communication apparatus, comprising:

a memory configured to store a plurality of domain names associated with e-mail addresses (page 2, paragraph 8, lines 3-4);

a panel configured to input at least one character of a user name of an e-mail address and an @ mark, and to select one domain name from the plurality of the domain names stored in the memory (page 2, paragraph 9, lines 1-2; page 5, paragraph 21, 22);

a display configured to display data (page 2, paragraph 8, lines 4-5); and

a controller configured to:

control the display to display the at least one character of the user name of the e-mail address input by the panel (page 2, paragraph 9, lines 10-11);

determine whether the @ mark is input by the panel when the at least one character of the user name of the e-mail address is displayed (page 8, paragraph 45);

determine whether the panel has been operated to select one domain name from the plurality of the domain names stored in the memory (page 8, paragraph 46);

control the display to display a domain name from the plurality of the domain names stored in the memory without inputting, by the panel, of a character after the @ mark, when the @ mark is determined to be input by the panel and when it is determined that the panel has been operated to select the domain name from the plurality of the domain

names stored in the memory (page 8, paragraph 45, lines 2-4; page 8, paragraph 46, lines 1-2; page 9, paragraph 46);

generate the e-mail address, based on the at least one character of the user name of the e-mail address input by the panel, the @ mark input by the panel, and the displayed domain name, when the displayed domain name is selected by the panel (page 9, paragraph 46, lines 3-5);

and transmit an e-mail to a destination, based on the generated e-mail address (page 1, paragraph 1).

Regarding claim 11, Naka discloses the data communication apparatus according to claim 10, wherein the panel comprises a up key and a down key, the up key being utilized for selecting a domain name prior to the displayed domain name, the down key being utilized for selecting a domain name after the displayed domain name, and, by use of one of the up key and the down key, selection of a domain name from the plurality of the domain names stored in the memory is performed (Drawing 9 on page 3 of Drawings shows selection of domain name wherein there is a domain list 1-3 and one is selected. It is inherent that there is mechanism using up/down key to select one of the domains listed. (page 7, paragraph 33-35)).

Allowable Subject Matter

5. The following is an examiner's statement of reasons for allowance:

In addition to the teachings of the claims 16 as a whole, the closest prior art of record failed to teach or suggest, "control the display to display one e-mail address from

the plurality of the e-mail addresses stored in the first memory, the one e-mail address including the at least one character input by the panel, when the at least one character of the user name of the e-mail is displayed;
determine whether the @ mark is input by the panel;
clear the one e-mail address displayed on the display, when the @ mark is input by the panel;" Therefore, claims 17 and 18 are allowable for depending on claim 16.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

6. Claims 12-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Other Prior Art Cited

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Japanese Patent Publication No. 10-322508 to Tanaka discloses control method for network facsimile device.

U.S. Patent Application Publication No. US 2001/0028469 A1 to Ooi et al disclose communication apparatus with e-mail address inputting.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

Art Unit: 2626

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

Beniyam Menberu

BM

10/06/2005

KAWilliams
KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER